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09/862,905	05/22/2001	Gary P. Kasner	1915.14US03	9685

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EXAMINER
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SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/862,905

Applicant(s)

KASNER ET AL.

Examiner

M. Safavi

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16, 17, 21-49, 51, 52, 54, 56 and 58-70 is/are pending in the application.
- 4a) Of the above claim(s) 35-48 and 61-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

### ***Election/Restriction***

Applicant's traversal of the restriction requirement, presented in paper no. 4, is acknowledged. The traversal is on the ground(s) that the Office Action has not shown that examination of all pending claims would impose an undue burden on the Examiner. This is not found persuasive because the restriction requirement, by itself, establishes that a serious burden would be placed upon the Examiner if more than one invention were to be examined, (e.g., the requirement for restriction sets forth the different classification of each invention as well as the distinction between the inventions). Thus, serious burden would be placed upon examiner to search all claims directed to a plurality, or all, inventions disclosed as well as address all claims to each invention in any and all rejections which may be directed to the plurality of disclosed and claimed inventions.

The requirement is still deemed proper and is therefore made FINAL.

Claims 35-48 and 61-70 remain withdrawn from further consideration.

### ***Claim Rejections - 35 USC § 251***

Claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered

in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The language/limitations presented within claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60, (particularly claims 16 and 49), deletes a limitation or limitations which had been presented within claims as by amendments, as well as argued as a basis for patentability over the applied and cited prior art, filed in response to rejections of claims 1, 4, 7, 8, and 9 of the issued patent no. 5,094,041.

Claims 16, 17, 21-34, (particularly claim 16), cancel limitations to --a first aperture extending through a first one of the plurality of vent panels "and interrupting at least a portion of the multiplicity of air passages therein"-- as had been inserted by amendment within claim 1 during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance. Claims 16, 17, 21-34, (particularly claim 16), cancel limitations to --a second aperture extending through a second one of the plurality

of vent panels "and interrupting at least a portion of the multiplicity of air passages therein"-- as had been inserted by amendment within claim 1 during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.

Claims 16, 17, 21-34, (particularly claim 16), cancel limitations to --at least one first aperture extending through the first vent panel "and interrupting at least a portion of the multiplicity of air passages"-- as had been inserted by amendment within claim 4 during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance. Claims 16, 17, 21-34, (particularly claim 16), cancel limitations to --at least one second aperture extending through the first vent panel "and interrupting at least a portion of the multiplicity of air passages"-- as had been inserted by amendment within claim 4 during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.

The deleted limitations alluded to above with respect to claims 1, 4, and 7 have also been argued as a basis for patentability of claims 1, 4, and 7 on pages 8, (lines 17-20), 9, (lines 18-21), 11, (lines 11-14), and 12, (lines 19-24), of the October 10, 1990 amendment, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.

Claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60, (particularly claims 16 and 49), cancel limitations to --a pocket defined by and extending at least partially through at least a one of the vent parts with "said pocket being spaced apart from the interior region by the vent part"-- as had been inserted by amendment within claim 8,

Art Unit: 3673

(amendment A and amendment D), during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance. Further, claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60, (particularly claims 16 and 49), cancel limitations to "said pocket being at least partially enclosed along a first side disposed closest to the interior region of the roof ventilator by said one of the vent parts" as well as "said pocket being at least partially enclosed along a second side disposed closest to the exterior region surrounding the roof ventilator by said one of the vent parts" as had been argued as a basis for patentability of claim 8 on pages 2-3 of the July 1, 1991 amendment, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.

Claims 16, 17, 21-34, (particularly claim 16), cancel limitations to --a recessed area cut in the top panel with the recessed area defining a plurality of openings with "each of said plurality of openings having a pair of side walls defined by the intermediate ply, each of said pair of side walls traversing a generally oval shaped path, such that the top panel may be manually folded across a path disposed within said recessed area"-- as had been inserted by amendment within claim 9, as well as argued on pages 4-5 of the March 4, 1991 amendment, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance. Claims 49, 51, 52, 54, 56, and 58-60, (particularly claim 49), cancel limitations to --a top panel disposed above a pair of vent parts and formed of a pair of planar plies and an intermediate ply, a recessed area cut in the top panel with the recessed area defining a plurality of openings with "each of said plurality of openings having a pair of side walls

Art Unit: 3673

defined by the intermediate ply, each of said pair of side walls traversing a generally oval shaped path, such that the top panel may be manually folded across a path disposed within said recessed area"-- as had been inserted by amendment within claim 9, as well as argued on pages 4-5 of the March 4, 1991 amendment, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance.

As such, Applicants' introduction of instant claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60 in the present reissue application would constitute an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 17, 21-34, 51, 52, and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 51, line 1, "said pluralities of first layer apertures" lacks a proper antecedent within the claim. Otherwise, to what does "said pluralities..." refer? Line 2, "said second layer apertures" lacks an antecedent within the claim.

With respect to claim 51, neither of claims 49 and 51 set forth "pluralities of first layer apertures" nor "second layer apertures".

***Response to Arguments***

Applicants' arguments filed September 22, 2003 have been fully considered but they are not persuasive. As set forth in the above rejection of claims 16, 17, 21-34, 49, 51, 52, 54, 56, and 58-60 under 35 USC 251 claims 16 and 49 do not present limitations presented upon amendment and argued during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance. Applicants' arguments with respect to any portion of recapture involving --a plurality of vent panels disposed in a stack "generally proximate to one another, [with] said plurality of vent panels defining said multiplicity of air passages"-- or --at least a first vent panel and a second vent panel connected to said first vent panel such that said first vent panel is disposed above said second vent panel "to form a stack, said first vent panel and said second vent panel defining said multiplicity of air passages"-- or --each of said pair of vent parts including a plurality of vent panels "which are interconnected and generally parallel to one another" and disposed in a stack "generally proximate to one another, said plurality of interconnected vent panels defining said multiplicity of air passages"-- as well as --a plurality of vent panels which are interconnected "and generally parallel to one another" are convincing as language within each of claims 16 and 49 serves to recite related replacement limitation which is broader than the omitted limitation but narrower than the "canceled" claim subject matter. However, the remaining portions of the improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based stands.



With respect to Applicants' argument to "Applicants simply cannot be required to include limitations amended into all issued claims, the instant claims fail to present the limitations inserted by amendment within claims 1, 4, 7, 8, and 9, as well as argued on within the October 10, 1990 and March 4, 1991 amendments, during prosecution of application serial no. 07/479,376 in order to place the application in condition for allowance. In other words, at least each of claims 16 and 49 do not present the language that had been amended and/or argued as a basis for patentability for any of claims 1, 4, 7, 8, and 9, during prosecution of application serial no. 07/479,376. Or, put another way, taken against each of claims 1, 4, 7, 8, and 9 separately, instant claims 16 and 49 deletes a limitation or limitations which had been presented within claims as by amendments, as well as argued as a basis for patentability over the applied and cited prior art, filed in response to rejections of claims 1, 4, 7, 8, and 9 of the issued patent no. 5,094,041.

As for Applicants' assertion that "claim 16 recites limitations characteristic of a different embodiment of the present invention than issued claim 1" or "pending claims 16 and 49...are materially narrower in other aspects of the invention", (as presented on pages 20-23, 25, 27, and 28 of the response with respect to claim 1 and on pages 25, 27, and 28 of the response with respect to claim 49), such would constitute recapture under 35 U.S.C. 251 as the omitted limitation is replaced by another limitation that is not related to the subject matter previously surrendered by applicant, even though the replacement limitation may be a material (narrowing) limitation, and even where the replacement limitation defines the claim over the prior art. If the reissue claim is broader

is some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *In re Clement*, 131 F.3d 1470, 45 USPQ2d 1165.

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,094,041 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3673

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

This application contains claims 35-48 and 61-70 drawn to an invention nonelected with traverse in Paper No. 4 and 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



**MICHAEL SAFAVI  
PRIMARY EXAMINER  
ART UNIT 354**

M. Safavi  
November 02, 2004